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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/431,849	11/02/99	NICKEL	0 BEIERSDORF-5

IM52/1010
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EXAMINER

FERGUSON, L

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/431,849

Applicant(s)

NICKEL, OILVER

Examiner

Lawrence D Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/20/01.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9 and 12 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed July 20, 2001.

Claim 1 was canceled and claim 12 was added, rendering Claims 2-9 and 12 pending with Claim 11 withdrawn under a restriction requirement

RESPONSE TO REQUEST FOR RECONSIDERATION

2. Applicant's election with traverse of Group II in Paper No. 9 is acknowledged. The traversal is on the ground(s) that "any search of the masking strip itself is certain to unveil any art pertaining to its use as well, so no undue additional burden would be placed on the Examiner in examining both groups together" is not persuasive. The search of the 2 subclasses would entail the requisite of serious burden, as the search for process of using is not the same as the article search. The Examiner would not expect to find a method for painting an automobile in the same class/subclass as a masking strip.

The requirement is deemed proper and is therefore made **FINAL**.

Claim Rejections – 35 USC 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2-9 and 12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not support the claimed language that Applicant uses in new claim 12. The specification does not mention a first side, second side, first edge or second edge. Additionally, the specification does not support "said second edge of said masking film extending beyond said second edge of said masking paper." Although a first side, second side and edge can be determined by looking at Figures 1-3, there is no support for a second edge by simply looking at Figures 1-3. Nowhere else in the specification is any of the amended language of claim 12 found.

Claim Rejections – 35 USC 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 2-9 and 12 are rejected under 35 U.S.C. 103(a) as being obvious over Patel et al. (US 5,385,783) in view of Sakumoto et al. (US 5,683,806) for the reasons set forth in paragraphs 10-13, in the previous office action, mailed January 17, 2001.

Response to Arguments

7. Applicant's arguments to rejection under 35 U.S.C. 112, mailed July 20, 2001 have been fully considered and are withdrawn.

8. Applicant's arguments to 35 USC § 103(a): Patel in view of Sakumoto, have been fully considered but are unpersuasive. On page 6, one of applicants main arguments is that, Patel's "coated paper does not have anything to do with Applicants novel strip, which has a paper extending over and beyond the lower edge of the adhesive tape and a film covering the paper and extending over and beyond the lower edge of the paper" and "nothing in Sakumoto would provide any of the elements that are present in Applicant's invention" is not persuasive. Patel in view of Sakumoto discloses a masking tape with the components Applicant claims as the invention, such as paper backing and film. Furthermore, the specification does not support a "paper extending over and beyond the lower edge of the adhesive tape and a film extending over and beyond the lower edge of the paper." Also it does not matter whether Patel has anything to do with Applicant's strip or that Patel's invention is not referred to as a masking strip. How the invention is named is of little consequence. The reference tape is made of the same materials as applicant claims and is used for the same purpose. Also the reference points out that its tape is used to cover certain parts of the automobile while painting for the result of painting straight lines.

Applicant argues that "in Applicant's invention, the elements comprising the masking strip are arranged in a novel way and relate to each other in a novel manner." Extending layers over one another is merely rearranging parts of an invention and involves only routine skill in the art. Merely extending a paper layer over an adhesive layer and extending a film covering over a

Art Unit: 1774

paper layer does not make Applicants invention novel. The reference tape's shape can be manipulated as well as the instant invention. Further it has been held obvious that rearranging the parts of an invention involves only routine skill in the art. In re Japiske 86 USPQ 70.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson/Art Unit 1774
October 3, 2001

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

